



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,060	08/01/2003	Tienyu Chiu	LUC-419/Chiu 4	3584
32205 7590 02/19/2008 PATTI, HEWITT & AREZINA LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER O'CONNOR, BRIAN T	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 02/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,060	Applicant(s) CHIU, TIENYU	
	Examiner Brian T. O'Connor	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to Applicant's amendment filed on 01/29/2008.
2. Claims 1 and 6 have been amended. Claims 1-10 are currently pending.
3. Due to applicant's amendment of claims 1 and 6 the 35 USC 112 (second) rejection of claims 1-10 is withdrawn.
4. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schessel (US 6,304,566) in view of Ress et al. (US 6,885,658; hereafter Ress).

With respect to claims 1 and 6, Schessel disclose a method for a central office (CO) device (16a of Figure 1A; viewed as a PSTN switch) to provide Internet subscribers with calling features (Abstract). The CO contains an IP interface (27 of Figure 1A; column 4, lines 44-53; viewed an equivalent to an IP peripheral unit) that accepts incoming IP packets with requests for call features (column 5, lines 33-53). The IP interface communicates with a trunk unit (29 of Figure 1A; column 4, lines 54-65; viewed as a packet line trunk unit) to check the subscribers eligibility for requested features. Next, a call processing processor (22 of Figure 1A; viewed as an applications processor) will communicate with a features database (32 of Figure 1A; column 4, lines 54-64; referred to as 35 of Figure 1A; viewed as a directory database) to verify the eligibility of the subscriber's request for a feature. If the feature indicates Internet usage then the CO will

transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include call ID and three-way calling (column 4, line 65 -- column 5, line 2). Schessel also shows an IP telephone (404 of Figure 3A) connected to the PSTN switch only by an IP connection (14' of Figure 3A).

However, Schessel fails to disclose a request with a telephone directory number of a called party.

Ress discloses a method where a number of gateways and agents (1800, 1802, 1804, 1806, 1808 of Figure 18; 1402, 1602 of Figure 19) that translate TCP/IP request messages into PSTN signal messages (Abstract; column 4, lines 34-54; column 18, lines 7-15). The setup message transmitted includes a telephone number of a called party (column 19, lines 27-35; line 2, line 3 of Figure 19).

Ress teaches the advantage of increased compatibility and greater flexibility of the gateways and agents (column 5, lines 15-35). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the gateways and agents with their setup messages as taught by Ress with the method of Schessel.

With respect to claims 2 and 7, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include caller ID and three-way calling (column 4, line 65 -- column 5, line 2). Caller ID information is sent back to the IP telephone set.

With respect to claims 3 and 8, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include caller ID and three-way calling (column 4, line 65 -- column 5, line 2). Caller ID information is sent to the called IP telephone set.

With respect to claims 4 and 9, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4), otherwise the CO will transmit to a POTS telephone on the PSTN network (214 of Figure 4).

With respect to claims 5 and 10, Schessel further discloses the features include call ID and three-way calling (column 4, line 65 -- column 5, line 2):

Response to Arguments

7. Applicant's arguments filed on 10/22/2007 have been fully considered but they are not persuasive.

A) Applicant argues, on page 6 (second full paragraph), with respect to claims 1 and 6 that the reference Schessel does not disclose "providing direct support from the PSTN switch itself to IP telephone set subscribers of call features where the IP telephone set subscribers are not also serviced by another wire line of the PSTN switch".

The examiner maintains the 35 USC 103(a) rejection of claims 1-10 as unpatentable over Schessel in view of Ress. Claim 1 recites "said PSTN switch only servicing said one subscriber via an IP connection to the first IP telephone set" and claim 6 recites "said PSTN switch only servicing said one subscriber via an IP connection to the first IP telephone set". As best understood by the Examiner, these features of claims 1 and 6 describe the system and method of Schessel because Schessel teaches an IP telephone set (404 of Figure 3A) that is only connected to a PSTN switch (16a' of Figure 3B) by an IP connection (14' of Figure 3A). The IP telephone set (404 of Figure 3A) does not have a wire line connection to the PSTN switch.

B) Applicant argues, on page 7 (first partial paragraph), with respect to claims 1 and 6 that the in Schessel "internet interface 27 appears to only be used in such a circumstances,

i.e. where the call service request comes from an existing wireline subscriber while using an IP device coupled to the IP network 14".

The Examiner maintains the 103(a) rejection of claims 1-10 because even though Schessel describes a situation where an IP telephone connection with a wireline subscriber through the PSTN switch as described in column 4, line 44 -- column 5, line 33, there is further description of Schessel's method in column 5, line 66 -- column 6, line 35. More specifically in column 6, lines 27-31, "the central office 16a converts central office protocol into TCP/IP IP network protocol for switching network 28 and routes call to called party via the IP network 14 using called party's TCP/IP IP network address protocol" and step 216 of Figure 2.

C) Applicant argues, on page 7 (first full paragraph), with respect to claims 1 and 6 that Schessel's system teaches a "gateway 32 converts the TCP/IP address to the called party's telephone directory number which is output from the gateway 32 to a trunk unit 23 of a central office. That is, it the purpose of the router server 30, which is external of the central office 16a to provide the conversion between a telephone directory number and a corresponding TCP/IP address".

The Examiner maintains the 103(a) rejection of claims 1-10 because the claims recited an IPPU, an applications processor, and a packet line trunk being internal to the PSTN switch. Other components for processing the call feature request are not found in the claim 1 and 6 to be recited as internal to the PSTN switch.

D) Applicant argues, on page 7 (second full paragraph), with respect to claims 1 and 6 that the claimed invention is a "the PSTN switch itself requires no external assistance in order to directly communicate with the process TCP/IP service requests".

The Examiner maintains the 103(a) rejection of claims 1-10 because the method of Shessel teaches PSTN switch with an Internet interface (27 of Figure 1A) that enables the

PSTN switch to process TCP/IP service request on its own by converting the service request to an internal protocol (c.o. protocol of Figure 1A).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. O'Connor whose telephone number is 571-270-1081. The examiner can normally be reached on 9:00AM-6:30PM, M-F, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

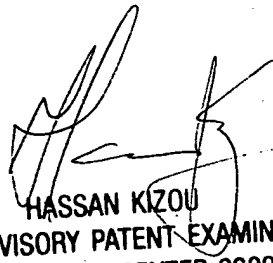
Application/Control Number:
10/633,060
Art Unit: 2619

Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BTO

Brian T. O'Connor
February 12, 2008
Patent Examiner



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600